

BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: RONALD JOHN ROSENBERGER Conf. No. 2238

Application No.: 10/822,051 Art. Unit: 3728

Filing Date: 04/10/2004 Examiner: John T. Kavanaugh

Title: **SCENTED SHOE SOLES**

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/Guy Kevin Townsend/

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REVISED APPELLANT'S BRIEF ON APPEAL UNDER 37 CFR 41.37

Dear Sir:

Appellant files this Revised Appellant's Brief on Appeal in response to each and every issued raised in the Notification of Non-Compliant Appeal Brief, mailed April 16, 2009, now due June 16, 2009, with a one-month extension and fee submitted herewith. Applicant has amended this Brief to address the issues raised by the Examiner and has also filed a petition to have the Figure 1 entered and accepted formally to proceed with this Appeal.

Real Party in Interest (37 CFR 41.37(c)(1)(i))

The Appellant-inventor, Ronald Rosenberger is the owner of entire interest in the above-identified patent application as the sole Appellant, and which interest has not been assigned.

Related Appeals and Interferences (37 CFR 41.37(c)(1)(ii))

There are no related appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal and accordingly there are no decisions to provide copies herewith.

Status of Claims (37 CFR 41.37(c)(1)(iii))

Claim 8 was canceled in response to a prior non-final office action. Pending claims 1-7 and 9-21, including independent claim 1, rejected under 35 USC 112.1, 102(b) or 103(a) as not enabled, or anticipated or obvious over the cited references. Appellants appeal and argue all of the claims 1-7 and 9-21 together, including independent claim 1.

Claims 1-7 and 9-21 are pending on Appeal. All of the claims 1-7 and 9-21, including independent claim 1, are argued together.

Status of Amendments (37 CFR 41.37(c)(1)(iv))

The Examiner did not enter Appellant's Amendment under 37 CFR 116, filed June 27, 2006, in response to the final Office Action of March 27, 2006, as indicated in an Advisory Action of record but not received by Appellant in the mail. The Examiner maintained his rejections in the final Office Action as indicated in the Advisory Action.

Claims 1-7 and 9-21 are pending on Appeal as amended in Applicant's response submitted March 10, 2006, to the Examiner's November 14, 2005, non-final Office Action. All of the claims 1-7 and 9-21, including independent claim 1, are argued together.

Summary of Claimed Subject Matter (37 CFR 41.37(c)(1)(v))

The presently claimed invention is specific to a shoe sole for a shoe comprising at least one scented plug or insert (as supported, e.g., at pages 3-7 of the specification). The following table provides independent claim 1 and its corresponding support in the specification.

<u>Independent claim</u>	<u>Specification Support</u>
<p>1. A shoe sole for a shoe comprising at least one scented material/formulation compound as a component of the shoe sole or as provided in a shoe sole plug or insert, where said scented material/formulation compound comprises at least one scent or fragrance</p> <p>(A) where said scented material/formulation compound gives off a desired aroma when said shoe sole is at rest;</p> <p>(B) where said scented material/formulation compound gives off a desired aroma when said shoe sole is in normal use due to friction, heat buildup, and wear; or</p> <p>(C) where said novelty scented material/formulation compound gives off a desired aroma when normal wear of said shoe sole exposes fresh surface area of said scented material/formulation compound,</p>	<p>p. 3-7: The present invention involves scenting the shoe's sole material/formulation compound(s) with at least one novelty scent or fragrance. The term "novelty scented shoes" is herein defined as shoes comprising scented sole material/formulation compound(s).</p> <p>In many scent related disclosures not having anything to do with the present invention, scent is used to mask offensive odors, such as room deodorizers. This is not the case with the present invention, where the unique aroma due to the novelty scent or fragrance added to the material/formulation compound is a salient, distinguishing, and marketable feature of the shoe comprising the novelty scented shoe sole, and may comprise any desired novelty scent or fragrance. The shoe comprising the novelty scented shoe sole gives off a unique aroma when the shoe is at rest, and when the shoe is in use. Friction, heat buildup, and wear due to use is an effective means of releasing the aroma; and wear of the novelty scented shoe sole serves to expose fresh surface area of the novelty scented material/formulation. Wear and tear of a given shoe has the greatest impact on</p>

and wherein said desired aroma comprises a salient, distinctive, and marketable feature of said shoe.	the sole of the shoe, and it is this wear and tear aspect that enable special dynamics of the disclosed sole to emerge. For purposes of this disclosure, the term “novelty scented shoes” refers to shoes comprising novelty scented shoe soles.
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Grounds of Rejection to be reviewed on Appeal (37 CFR 41.37(c)(1)(vi))

The Examiner did not enter Appellant’s Amendment under 37 CFR 116, filed June 27, 2006, in response to the final Office Action of March 27, 2006, as indicated in an Advisory Action of record but not received by Appellant in the mail. The Examiner maintained his rejections in the final Office Action as indicated in the Advisory Action.

Claims 1-7 and 9-21 are pending on Appeal, with all claims 1-7 and 9-21, including independent claim 1, argued together.

The following is a concise statement of each ground of rejection presented for review:

1. The Examiner objects to the specification and drawing under 37 CFR 1.83(a) and 35 USC 132 for adding new matter, as presented in paragraphs 1-3 on pages 2-4 of the final Office Action.
2. The Examiner rejects claim 9 under 35 USC, Section 112, first paragraph, as presented in paragraph 5 on page 4 of the final Office Action.
3. The Examiner rejects claims 1-7 and 9-21 under 35 USC 112, second paragraph, as indefinite, as presented in paragraph 6 on pages 4-5 of the final Office Action.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hartung, et al. (US 4,257,176) as presented in paragraph 8 on page 5 of the final Office Action.
5. Claims 1, 6-7, 9, 11, 14, 15, 17, 18, 19-21 are rejected under 35 U.S.C. 102(b), as being anticipated by Laughlin, et al. (US 5,732,485) as presented in paragraph 9 on pages 5-6 of the final Office Action.
6. Claims 12 and 13 are rejected under 35 U.S.C. 102(b), as being anticipated by, or under 35 U.S.C. 103(a) as obvious over, Laughlin, et al. (US 5,732,485) as presented in paragraph 9 on pages 5-6 of the final Office Action.
7. Claim 10 is rejected under 35 U.S.C. 103(a) are being unpatentable over Laughlin '485 as presented in paragraph 11 on pages 6-7 of the final Office Action.
8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin '485 in view of Maples (US 5,024,008) as presented in paragraph 12 on page 7 of the final Office Action.
9. Claims 3 and 16 are rejected under 35 U.S.C. 103(a) are being unpatentable over Laughlin '485 in view of Williford (US 5,261,169) as presented in paragraph 12 on page 7 of the final Office Action.
10. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) are being unpatentable over Laughlin '485 in view of O'Brien (US 5,039,243) as presented in paragraph 13 on pages 7-8 of the final Office Action.

Arguments (37 CFR 41.37(c)(1)(vii))

The Examiner did not enter Appellant's Amendment under 37 CFR 116, filed June 27, 2006, in response to the final Office Action of March 27, 2006, as indicated in an Advisory Action of record but not received by Appellant in the mail. The Examiner maintained his rejections in the final Office Action as indicated in the Advisory Action.

Claims 1-7 and 9-21 and Figure 1 are pending on Appeal, with claims 1-7 and 9-21, including independent claim 1, argued together.

Argument 1 under (37 CFR 41.37(c)(1)(vii)): The Examiner objects to the specification and drawing under 37 CFR 1.83(a) and 35 USC 132 for adding new matter in paragraphs 1-3 on pages 2-4 of the final Office Action.

The Examiner objects to the specification and drawings under 37 CFR 1.83(a) and 35 USC 132 as failing to have figure description added to the specification and for adding new matter as presented in paragraphs 1-3 on pages 2-4 of the final Office Action, asserting that the figures must have a corresponding description in the specification, include all of the limitations of the claims, be supported by the specification, and that new drawings should be provided showing each of the claimed features of the invention, including "shoe sole," "scented compound," "visual aspect," "two or more plugs or inserts".

37 CFR 183(a) states that (*emphasis added*):

§ 1.83 Content of drawing.

(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 USC 371, not permitted to be included in the drawings.

Appellant submitted Figure 1 in the response filed March 14, 2006, to the non-final Office Action of November 11, 2005, specifically meeting the requirements of 37 CFR 1.83(a), where Appellant provided Figure 1, as fully supported by the present specification (e.g., as shown below). Figure 1 clearly has corresponding description in the specification, includes all of the limitations of the claims, and shows each of the claimed features of the invention, including “shoe sole,” “scented compound,” “visual aspect,” “two or more plugs or inserts”. In particular, this Figure 1 shows, according to 37 CFR 1.83(a) as cited by the Examiner, “conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation.” Appellant/Petitioner respectfully points out that the provided Figure 1 shows conventional features in the form of a graphical drawing symbol, according to 183(a), and submits that this Figure meets 37 CFR 1.183(a).

With regard to the new matter rejection, Appellant respectfully points out that the terms and description supporting the provided Figure 1 for the terms and drawing of “shoe sole”, “scented compound”, “receptacle”, and “scented plug or insert” are fully supported by the original and present specification, inter alia, as follows, throughout pages 6-23 of the present specification:

SUMMARY OF THE INVENTION

The present invention involves scenting the shoe's sole material/formulation compound(s) with at least one novelty scent or fragrance. The term “novelty scented shoes” is herein defined as shoes comprising scented sole material/formulation compound(s).

In many scent related disclosures not having anything to do with the present invention, scent is used to mask offensive odors, such as room deodorizers. This is not the case with the present invention, where the unique aroma due to the novelty scent or fragrance added to the material/formulation compound is a salient, distinguishing, and marketable feature of the shoe comprising the novelty scented shoe sole, and may comprise any desired novelty scent or fragrance. The shoe comprising the novelty scented shoe sole gives off a unique aroma when the shoe is at rest, and when the shoe is in use. Friction, heat buildup, and wear due to use is an effective means of releasing the aroma; and wear of the novelty scented shoe sole serves to expose fresh surface area of the novelty scented material/formulation. Wear and tear of a given shoe has the greatest impact on the sole of

the shoe, and it is this wear and tear aspect that enable special dynamics of the disclosed sole to emerge. For purposes of this disclosure, the term “novelty scented shoes” refers to shoes comprising novelty scented shoe soles.

The intended purpose of embellishing shoe soles with novelty scent or fragrance is to provide a marketable feature to end-users. For example, nine and ten year old girls could respond favorably, if not preferably, to athletic shoes that feature cherry or strawberry scented soles. A golfer could get a kick out of golf shoes that smell like turf, or better yet, hundred dollar bills. The purpose of scent is to provide an additional reason for a given purchaser to select the scented product over another that isn’t scented. A dream scenario for a manufacturer offering athletic shoes comprising novelty scented soles would be where a given purchaser struggles with whether to buy the vanilla scented shoes, versus the cherry scented shoes, versus the orange scented shoes, where said purchaser is totally ignoring a competitor’s unscented athletic shoes.

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DETAILED DESCRIPTION OF THE INVENTION

[Page 8]

The disclosed shoe comprises any footwear, such as any athletic or exercise shoes, any work or hunting boots, any casual shoe or casual boots, any dress shoe or dress boots, any open-toed shoes or sandals, any slippers, etc.

The scenting agent(s) for the novelty scented shoe soles may comprise any scent producing agent(s) such as those comprising, but not limited to, water, oil, or glycol soluble scents, in any range of scent or fragrance concentration that achieves the desired aesthetic result. The aroma of the scenting agent(s) may comprise any desired aroma, such as citrus scents (lemon, orange, etc.), fruity scents (coconut, cherry, etc.), spice scents (cinnamon, vanilla, etc.), to the earlier mentioned less usual scenting aromas (grass, money, etc.). Also, the scenting agent(s), as used in the novelty scented shoe soles, may comprise any kind(s) of pheromone(s) in place of, or in addition to, the abovementioned at least one novelty scent or fragrance.

Known construction materials for shoe soles comprise different types of rubber, treated leathers, and other materials synthetic in nature. The disclosed novelty scented shoe soles can comprise the use of any suitable construction materials.

The shoe soles may be scented or fragranced by any possible means, such as where at least one scent or fragrance is added as an ingredient to the shoe sole material/formulation compound; or where the material/formulation compound is laced with encapsulated or microencapsulated scent(s) or fragrance(s), and/or pheromone(s), either with or without the basic material/formulation compound being scented itself; or even where a finished shoe sole, or the pre-fabrication sole material(s), such as leather or rubber sole material, is coated with or steeped in a scenting or fragrancing means, all of which, for purposes of this disclosure, are to be known as novelty scented sole material/formulation compounds.

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[page 10]

Another means of scenting the shoe soles is to use novelty scented plugs or inserts. For the sake of disclosure, a novelty scented plug or insert may comprise pheromones in place of, or in addition to, novelty scent or fragrance; may comprise other attributes in addition to novelty scent or fragrance and/or pheromones, that will be discussed later; or may even comprise said other attributes in place of said novelty scent or fragrance and/or pheromones.

A novelty scented plug or insert can be installed on the disclosed shoe sole that comprises novelty scented material/formulation compound, and/or pheromones, or it may be installed on shoe soles not comprising any of the abovementioned attributes. What is important is that the shoe sole comprises at least one void anywhere on the surface of the sole where the void comprises a receptacle that is intended for and allows for the insertion of at least one novelty plug or insert. A clarification is in order here. While the term “anywhere on the surface” mostly pertains to the wearable surface of the shoe sole, a void *can* occur on a non-wearing surface of the sole, where the novelty scented plug exists to emit scent *sans* wear. Such would comprise a void or receptacle for a novelty plug or insert on the side of the sole, or even a void or receptacle *around* the non-wearing circumference of the entire shoe sole, and/or around the non-wearing circumference of the heel portion of the sole, and/or around the non-wearing circumference of the non-heel portion of the sole, any of which that are visible from above when the shoe is worn on the user’s foot.

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A given novelty scented plug or insert, and its corresponding void or receptacle can comprise any shape, design, directional orientation, size, or depth. Also, a plug or insert can comprise a shape that fills a void in the form of a groove, channel, or crevice comprising any shape, design, design pattern, directional orientation, size, or depth.

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The novelty scented plug may be scented using any of the means disclosed earlier for the scented material/formulation compound. The novelty scented plug or insert can comprise any color, or if desired, colors. The novelty scented plug or insert can comprise any material/formulation compound; however, the material/formulation compound that is ultimately used should be carefully considered, because if the material/formulation compound used for a novelty scented plug or insert, especially in the wearable surface, is too hard compared to the shoe sole material/formulation compound, excess noise and/or friction can result. If the material/formulation compound is too soft, then excess debris can get lodged in the material/formulation compound. While best bets for the novelty-scented plug or insert material/formulation compound are compounds similar, if not identical, to the material/formulation compounds used in the actual shoe sole. For the

sake of disclosure, the novelty scented plugs or inserts can comprise material formulation/compounds identical to, similar to, or different from the material formulation/compound comprising the shoe sole.

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The novelty scented plug or insert may comprise a plug or insert comprising multi-sectional construction, where a singular novelty plug or insert comprises two or more sections, where any one given section, or even two or more sections, can be oriented either along the depth of the novelty plug or insert, and/or along or across the surface area that is visible on the shoe sole after installation (where the two or more sections are side by side; or, where two or more sections are side by side, over top of a third section that is hidden underneath). Furthermore, any one given section can comprise any one, or any combination or permutation comprising more than one, of the following attributes: at least one material compound; at least one color; at least one novelty scent and/or fragrance; at least one pheromone; at least one novelty visual aspect; or at least one smoke releasing means. The combinations are endless and versatile. For instance, a singular novelty plug or insert comprising two sections (a top and bottom section) along the depth can have a cherry scented *red* glitter section adjacent to the wear surface of a new shoe sole; then, when the sole and the novelty plug or insert both wear down, the bottom section of the novelty plug or insert comprising a lemon scented *yellow* glitter section is revealed. Likewise, the top section of a novelty plug or insert can comprise pink glitter that smells like bubblegum, or be just an unscented top section, that wears down to the abovementioned smoke releasing mechanism that gives off an orange smoke.

Making the novelty scented plugs or inserts may comprise solid plugs or inserts that are formed by any forming means including plugs or inserts that comprise any means of molding, casting, die cutting, extruding and cutting, molding and cutting, casting and cutting, etc. For example, a given plug or insert may be injection molded into the desired shape.

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Voids in the soles may occur using any void creating means. For example, in the case of an athletic shoe sole, such may be attained by having the void(s) molded along with the other design features of the sole during the manufacturing process, or the void(s) can be created by void creating means such as milling, drilling, etc. It is intended that a given novelty scented plug or insert is designed, or is able to be modified, to be inserted in a corresponding void or receptacle of the shoe sole by any possible inserting or installing means, either automatically by machine, or by hand with or without the use of tools. Also, it is intended that a given novelty scented plug or insert can be secured in the corresponding void or receptacle of the shoe sole using any securing means, whether said novelty scented plug or insert is glued in, pressure-fitted, heat set, screwed in, set using grooves or serrations on the plug and/or the shoe sole, held by elastic means, etc.

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Finally, it could possibly be desirable that a given novelty plug or insert be removed from the void of the disclosed shoe sole for whatever reason, such as after a plug comprising smoking means has deployed, and the end user wishes to install a new plug comprising smoking means. Any removing means may be contemplated as an antidote to overcome prior installation, even if such removing means are as basic as using tweezers, a drill or a dremel tool to remove the novelty plug or insert, or remnants of a deployed novelty plug or insert comprising smoking means; however, removal may be as simple as where a novelty plug or insert comprising a scented and sparkly “O” ring around the circumference of the sole, and comprising qualities similar to a rubber band, is simply stretched and removed, and replaced just as easily.

Accordingly, Appellant asserted and maintains that Figure 1 is fully supported by the present specification, the figures clearly have a corresponding description in the specification, include all of the limitations of the claims, and showing each of the claimed features of the invention, including “shoe sole,” “scented compound,” “visual aspect,” “two or more plugs or inserts”.

Appellant submits that this rejection is in error and should be reversed.

Argument 2 under (37 CFR 41.37(c)(1)(vii): The Examiner rejects claim 9 under 35 USC, Section 112, first paragraph as presented in paragraph 5 on page 4 of the final Office Action.

The Examiner rejects claim 9 under 35 USC, Section 112, first paragraph, as presented in paragraph 5 on page 4 of the final Office Action, as failing to comply with the enablement requirement, asserting that claim 9 lacks clarity by the use of the term “void can accommodate said at least one scented plug or insert comprising any embodiment of an O-ring around the non-wearing circumference of the entire shoe,” as the description of the “ring” in the specification was not understood by the Examiner.

The objected-to terms are fully supported by the present specification, e.g., inter alia, as follows at the top of page 11 (emphasis added):

“A novelty scented plug or insert can be installed on the disclosed shoe sole that comprises novelty scented material/formulation compound, and/or pheromones, or it may be installed on shoe soles not comprising any of the abovementioned attributes. What is important is that the shoe sole comprises at least one void anywhere on the surface of the sole where the void comprises a receptacle that is intended for and allows for the insertion of at least one novelty plug or insert. A clarification is in order here. While the term “anywhere on the surface” mostly pertains to the wearable surface of the shoe sole, a void *can* occur on a non-wearing surface of the sole, where the novelty scented plug exists to emit scent *sans* wear. Such would comprise a void or receptacle for a novelty plug or insert on the side of the sole, or even a void or receptacle around the non-wearing circumference of the entire shoe sole, and/or around the non-wearing circumference of the heel portion of the sole, and/or around the non-wearing circumference of the non-heel portion of the sole, any of which that are visible from above when the shoe is worn on the user’s foot. The void(s) can allow for, say, one or more scented and sparkly novelty plug(s) or insert(s) comprising one or more “O” ring(s) comprising novelty scented material/formulation compound, where a given “O” ring is elastic or semi-elastic, and perhaps has qualities similar to a rubber band or an elastic hair band that can be stretched on or off the sole of the shoe, and can be easily replaced at will.”

Additionally, pages 15-16 further describe the use of voids and O rings:

Voids in the soles may occur using any void creating means. For example, in the case of an athletic shoe sole, such may be attained by having the void(s) molded along with the other design features of the sole during the manufacturing process, or the void(s) can be created by void creating means such as milling, drilling, etc. It is intended that a given novelty scented plug or insert is designed, or is able to be modified, to be inserted in a corresponding void or receptacle of the shoe sole by any possible inserting or installing means, either automatically by machine, or by hand with or without the use of tools. Also, it is intended that a given novelty scented plug or insert can be secured in the corresponding void or receptacle of the shoe sole using any securing means, whether said novelty scented plug or insert is glued in, pressure-fitted, heat set, screwed in, set using grooves or serrations on the plug and/or the shoe sole, held by elastic means, etc.

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Finally, it could possibly be desirable that a given novelty plug or insert be removed from the void of the disclosed shoe sole for whatever reason, such as after a plug comprising smoking means has deployed, and the end user wishes to install a new plug comprising smoking means. Any removing means may be contemplated as an antidote to overcome prior installation, even if such removing means are as basic as using tweezers, a drill or a dremel tool to remove the novelty plug or insert, or remnants of a deployed novelty plug or insert comprising smoking means; however, removal may be as simple as where a

novelty plug or insert comprising a scented and sparkly “O” ring around the circumference of the sole, and comprising qualities similar to a rubber band, is simply stretched and removed, and replaced just as easily.

Accordingly the specification fully discloses and enables the rejected term according to 35 USC 112, first and second paragraphs.

This rejection should be reversed as being in error.

Argument 3 under (37 CFR 41.37(c)(1)(vii): The Examiner rejects claims 1-7 and 9-21 under 35 USC 112, second paragraph, as indefinite, as presented in paragraph 6 on pages 4-5 of the final Office Action.

The Examiner has rejected claims 1-7 and 9-21 under 35 USC 112, second paragraph, as indefinite, for the reasons presented on pages 4-5 of the final Office Action, in particular objecting to:

- (a) the terms “etc.”, generally in the claims;
- (b) the functional recitation of scented material/compound while the term scented material is positively recited and “void creating means” in claim 6,
- (c) the recitation of the term “does not comprise said at least one scented ... smoking means” is not understood as to what is being claimed in claim 7;
and
- (d) the recitation of the plug or insert having multi-sectional construction not being understood in claim 18.

Appellant disagrees with the Examiner, and asserts that the claims are definite under 112, 2nd paragraph. The objected to terms are fully definite in the context of the teaching and description of the specification, e.g., as cited above for the rejection of Figure 1 for added matter. In the context of the specification, from which the claim terms are interpreted for definiteness under 112, second paragraph, the objected to terms are not indefinite under

35 USC section 112.2, in that the specification fully describes this term to one of ordinary skill in the art, e.g., on Page 9 as follows:

“ ... any smoking means that deploys or releases non-colored or colored smoke, where the deployment of said smoke acts as an entertaining or amusing visual effect, especially for younger shoe wearers. One means of doing this is by having one or more layers of smoke emitting material within the shoe sole itself, where the smoke deploys at certain wear levels. Another way to release colored or non-colored smoke is by employing any encapsulated means embedded in the material/formulation compound, where the encapsulated means uses capsules or microcapsules that rupture due to exposure and wear, thereby releasing non-colored/colored smoke. Smoke may be attained using any means, such as through a chemical reaction, or the release of a powder that deploys airborne particles. Such encapsulated means could be concentrated in a particular area of the sole material/formulation compound, or may be randomly distributed in the sole material/formulation compound, where the colored or uncolored smoke deploys at any given moment due to random wear, thereby adding an element of “surprise” to the wearer. It is possible in certain embodiments to have this smoke feature in addition to either scented or unscented sole material/formulation compounds”.

Thus, e.g., the term “smoking means” is definite under 35 USC section 112.2.

With regard to (d) above, this term is not indefinite under 35 USC section 112.2, in that the specification fully describes this term to one of ordinary skill in the art, on Page 13 as follows:

“The novelty scented plug or insert may comprise a plug or insert comprising multi-sectional construction, where a singular novelty plug or insert comprises two or more sections, where any one given section, or even two or more sections, can be oriented either along the depth of the novelty plug or insert, and/or along or across the surface area that is visible on the shoe sole after installation (where the two or more sections are side by side; or, where two or more sections are side by side, over top of a third section that is hidden underneath).”

Accordingly the term “multi-sectional construction” is definite under 35 USC section 112.2.

These rejections should be reversed as being in error.

Argument 4 under (37 CFR 41.37(c)(1)(vii): Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hartung, et al. (US 4,257,176) as presented in paragraph 8 on page 5 of the final Office Action.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hartung, et al. (US 4,257,176). Hartung, et al. disclosed, per the abstract: “An insole for footwear has odor masking or malodor counteractant material dissolved, trapped or encapsulated in a somewhat resilient resin coating through which it will progressively migrate or bleed under application of foot loads, foot perspiration and elevated foot temperatures to the surface of the coating to be released into the footwear to mask or counteract foot odors.”

However, the cited reference has nothing to do with the claimed invention as recited in the pending claims and in the specification. Appellant’s invention claims and describes an exterior sole that has scented material added to the exterior sole material itself or to inserts that gives off a novelty scent (novelty has been removed due to rejections by the Examiner).

The claimed invention has nothing to do with insoles and the Examiner has simply redefined the claimed invention to include insoles in order to read the claims onto the prior art when the claims and the specification have nothing to do with insoles. This is specifically stated and taught by the present specification, e.g., under the Summary of the Invention, second paragraph on page 6: “In many scent related disclosures not having anything to do with the present invention, scent is used to mask offensive odors, such as room deodorizers.”

Claim 1 recites a shoe sole for a shoe (which does not include an insole, the normal use of the term sole refers to the exterior sole only) as an exterior sole, as fully supported by the present specification, e.g., at pages 3-7.

Hartung ‘176 is an insole that is separate and distinct from the claimed sole of a shoe, where the insole is inserted into the inside of the shoe as distinct from the existing

exterior sole of the shoe. As distinct from the presently claimed invention, an insole is separate and distinct from a shoe sole. An insole is an after market product that is inserted inside a shoe that already has a sole. An insole is put inside shoe, separate from the shoe itself.

Additionally the presently claimed invention provides a novelty scent due to the presence of a scented material that is on the exterior of the shoe sole, that gives off a novelty scent due to wear of the exterior sole from normal use or wear.

Unlike the present invention, Hartung does not come in direct contact with indoor and outdoor ground surfaces such as pavements, floor coverings, etc. An intended purpose for Hartung is “to mask or counteract foot odors”, whereby the present invention has no deodorizing aspects for insoles, but is rather meant to provide a scent to the exterior outer sole of the shoe, boot, etc.

Thus, the present invention does not recite, disclose or include insoles, but discloses and claims exterior soles that have scented or fragrant inserts or plugs have a desired aroma. Accordingly, the cited reference fails to disclose each and every element of the present claims.

Furthermore, the present invention “teaches away” from the cited reference with regards to the intended purpose of the use of scent. In Hartung, the primary intended purpose of scent is to mask or counteract foot odors, whereby the present invention teaches away from Hartung in that the primary intended purpose of the scent is as an attractive feature to the shoe wearer that influences the purchasing and wearing of the shoe, and therefore, unlike Hartung, has no relation whatsoever to the addressing or mitigating of foot odor issues.

Accordingly, the present claims distinguish over and teach away from the cited reference. Appellant respectfully requests reconsideration and withdrawal of this rejection.

This rejection should be reversed as being in error.

Argument 5 under (37 CFR 41.37(c)(1)(vii): Claims 1, 6-7, 9, 11, 14, 15, 17, 18, 19-21

are rejected under 35 U.S.C. 102(b), as being anticipated by Laughlin, et al. (US 5,732,485) as presented in paragraph 9 on pages 5-6 of the final Office Action.

Claims 1, 6-7, 9, 11, 14, 15, 17, 18, 19-21 are rejected under 35 U.S.C. 102(b), as being anticipated by Laughlin, et al. (US 5,732,485). Laughlin, et al. comprises, per the abstract: “A deodorizer for masking foot and shoe odors through controlled release of fragrance...” whereby said deodorizer is installed in “the interior surface of a shoe”, where the user’s foot resides, i.e., the insole.

Laughlin ‘485, as is Hartung ‘176 relates to an insole to mask or counteract foot odors using a deodorizing insole, whereby the present invention has no deodorizing aspects for insoles, but is rather meant to provide a scent to the exterior outer sole of the shoe. Additionally, there is no suggestion in Laughlin for scenting the exterior sole of a shoe, as presently claimed.

However, the cited reference has nothing to do with the claimed invention as recited in the pending claims and in the specification. Appellant’s invention claims and describes an exterior sole that has scented material added to the exterior sole material itself or to inserts that gives off a novelty scent (novelty has been removed due to rejections by the Examiner).

The claimed invention has nothing to do with insoles and the Examiner has simply redefined the claimed invention to include insoles in order to read the claims onto the prior art when the claims and the specification have nothing to do with insoles. This is specifically stated and taught by the present specification, e.g., under the Summary of the Invention, second paragraph on page 6: “In many scent related disclosures not having anything to do with the present invention, scent is used to mask offensive odors, such as room deodorizers.”

Claim 1 recites a shoe sole for a shoe (which does not include an insole, the normal use of the term sole refers to the exterior sole only) as an exterior sole, as fully supported by the present specification, e.g., at pages 3-7.

Laughlin is an insole that is separate and distinct from the claimed sole of a shoe, where the insole is inserted into the inside of the shoe as distinct from the existing exterior sole of the shoe. As distinct from the presently claimed invention, an insole is separate and distinct from a shoe sole. An insole is an after market product that is inserted inside a shoe that already has a sole. An insole is put inside shoe, separate from the shoe itself.

Additionally the presently claimed invention provides a novelty scent due to the presence of a scented material that is on the exterior of the shoe sole, that gives off a novelty scent due to wear of the exterior sole from normal use or wear.

Unlike the present invention, Laughlin does not come in direct contact with indoor and outdoor ground surfaces such as pavements, floor coverings, etc. An intended purpose for Laughlin is “to mask or counteract foot odors”, whereby the present invention has no deodorizing aspects for insoles, but is rather meant to provide a scent to the exterior outer sole of the shoe, boot, etc.

Thus, the present invention does not recite, disclose, include or suggest insoles, but discloses and claims scented shoe soles. Accordingly, the cited reference fails to disclose, teach or suggest each and every element of the present claims.

Furthermore, the present invention “teaches away” from the cited reference with regards to the intended purpose of the use of scent. In Laughlin, the primary intended purpose of scent is to act as “[a] deodorizer for masking foot and shoe odors”, whereby the present invention teaches away from Laughlin in that the primary intended purpose of the scent is as an attractive feature to the shoe wearer that influences the purchasing and the wearing of the shoe, and therefore, unlike Laughlin, has no relation whatsoever to the addressing or mitigating of foot and shoe odor issues.

Accordingly, the present claims distinguish over and teach away from the cited reference. Accordingly, Appellant respectfully requests reconsideration and withdrawal of this rejection.

This rejection should be reversed as being in error.

Argument 6 under (37 CFR 41.37(c)(1)(vii): Claims 12 and 13 are rejected under 35 U.S.C. 102(b), as being anticipated by, or under 35 U.S.C. 103(a) as obvious over, Laughlin, et al. (US 5,7,32,485) as presented in paragraph 9 on pages 5-6 of the final Office Action.

Laughlin, et al. comprises, per the abstract: “A deodorizer for masking foot and shoe odors through controlled release of fragrance...” whereby said deodorizer is installed in “the interior surface of a shoe”, where the user’s foot resides, i.e., the insole.

Laughlin ‘485, as is Hartung ‘176 relates to an insole to mask or counteract foot odors using a deodorizing insole, whereby the present invention has no deodorizing aspects for insoles, but is rather meant to provide a scent to the exterior outer sole of the shoe. Additionally, there is no suggestion in Laughlin for scenting the exterior sole of a shoe, as presently claimed.

However, the cited reference has nothing to do with the claimed invention as recited in the pending claims and in the specification. Appellant’s invention claims and describes an exterior sole that has scented material added to the exterior sole material itself or to inserts that gives off a novelty scent (novelty has been removed due to rejections by the Examiner).

The claimed invention has nothing to do with insoles and the Examiner has simply redefined the claimed invention to include insoles in order to read the claims onto the prior art when the claims and the specification have nothing to do with insoles. This is

specifically stated and taught by the present specification, e.g., under the Summary of the Invention, second paragraph on page 6: “In many scent related disclosures not having anything to do with the present invention, scent is used to mask offensive odors, such as room deodorizers.”

Claim 1, from which claims 8, 12 and 13 depend, recites a shoe sole for a shoe (which does not include an insole, the normal use of the term sole refers to the exterior sole only) as an exterior sole, as fully supported by the present specification, e.g., at pages 3-7.

Laughlin is an insole that is separate and distinct from the claimed sole of a shoe, where the insole is inserted into the inside of the shoe as distinct from the existing exterior sole of the shoe. As distinct from the presently claimed invention, an insole is separate and distinct from a shoe sole. An insole is an after market product that is inserted inside a shoe that already has a sole. An insole is put inside shoe, separate from the shoe itself.

Additionally the presently claimed invention provides a novelty scent due to the presence of a scented material that is on the exterior of the shoe sole, that gives off a novelty scent due to wear of the exterior sole from normal use or wear.

Unlike the present invention, Laughlin does not come in direct contact with indoor and outdoor ground surfaces such as pavements, floor coverings, etc. An intended purpose for Laughlin is “to mask or counteract foot odors”, whereby the present invention has no deodorizing aspects for insoles, but is rather meant to provide a scent to the exterior outer sole of the shoe, boot, etc.

Thus, the present invention does not recite, disclose, include or suggest insoles, but discloses and claims scented shoe soles. Accordingly, the cited reference fails to disclose, teach or suggest each and every element of the present claims.

Furthermore, the present invention “teaches away” from the cited reference with regards to the intended purpose of the use of scent. In Laughlin, the primary intended purpose of

scent is to act as “[a] deodorizer for masking foot and shoe odors”, whereby the present invention teaches away from Laughlin in that the primary intended purpose of the scent is as an attractive feature to the shoe wearer that influences the purchasing and the wearing of the shoe, and therefore, unlike Laughlin, has no relation whatsoever to the addressing or mitigating of foot and shoe odor issues.

Accordingly, the present claims distinguish over and teach away from the cited reference. Accordingly, Appellant respectfully requests reconsideration and withdrawal of this rejection.

This rejection should be reversed as being in error.

Argument 7 under (37 CFR 41.37(c)(1)(vii): Claim 10 is rejected under 35 U.S.C. 103(a) are being unpatentable over Laughlin ‘485 as presented in paragraph 11 on pages 6-7 of the final Office Action.

Laughlin, et al. comprises, per the abstract: “A deodorizer for masking foot and shoe odors through controlled release of fragrance...” whereby said deodorizer is installed in “the interior surface of a shoe”, where the user’s foot resides, i.e., the insole.

Laughlin ‘485, as is Hartung ‘176 relates to an insole to mask or counteract foot odors using a deodorizing insole, whereby the present invention has no deodorizing aspects for insoles, but is rather meant to provide a scent to the exterior outer sole of the shoe. Additionally, there is no suggestion in Laughlin for scenting the exterior sole of a shoe, as presently claimed.

However, the cited reference has nothing to do with the claimed invention as recited in the pending claims and in the specification. Appellant’s invention claims and describes an exterior sole that has scented material added to the exterior sole material itself or to inserts that gives off a novelty scent (novelty has been removed due to rejections by the Examiner).

The claimed invention has nothing to do with insoles and the Examiner has simply redefined the claimed invention to include insoles in order to read the claims onto the prior art when the claims and the specification have nothing to do with insoles. This is specifically stated and taught by the present specification, e.g., under the Summary of the Invention, second paragraph on page 6: “In many scent related disclosures not having anything to do with the present invention, scent is used to mask offensive odors, such as room deodorizers.”

Claim 1, from which claim 10 depends, recites a shoe sole for a shoe (which does not include an insole, the normal use of the term sole refers to the exterior sole only) as an exterior sole, as fully supported by the present specification, e.g., at pages 3-7.

Laughlin is an insole that is separate and distinct from the claimed sole of a shoe, where the insole is inserted into the inside of the shoe as distinct from the existing exterior sole of the shoe. As distinct from the presently claimed invention, an insole is separate and distinct from a shoe sole. An insole is an after market product that is inserted inside a shoe that already has a sole. An insole is put inside shoe, separate from the shoe itself.

Additionally the presently claimed invention provides a novelty scent due to the presence of a scented material that is on the exterior of the shoe sole, that gives off a novelty scent due to wear of the exterior sole from normal use or wear.

Unlike the present invention, Laughlin does not come in direct contact with indoor and outdoor ground surfaces such as pavements, floor coverings, etc. An intended purpose for Laughlin is “to mask or counteract foot odors”, whereby the present invention has no deodorizing aspects for insoles, but is rather meant to provide a scent to the exterior outer sole of the shoe, boot, etc.

Thus, the present invention does not recite, disclose, include or suggest insoles, but discloses and claims scented shoe soles. Accordingly, the cited reference fails to disclose, teach or suggest each and every element of the present claims.

Furthermore, the present invention “teaches away” from the cited reference with regards to the intended purpose of the use of scent. In Laughlin, the primary intended purpose of scent is to act as “[a] deodorizer for masking foot and shoe odors”, whereby the present invention teaches away from Laughlin in that the primary intended purpose of the scent is as an attractive feature to the shoe wearer that influences the purchasing and the wearing of the shoe, and therefore, unlike Laughlin, has no relation whatsoever to the addressing or mitigating of foot and shoe odor issues.

Accordingly, the present claims distinguish over and teach away from the cited reference. Accordingly, Appellant respectfully requests reconsideration and withdrawal of this rejection.

This rejection should be reversed as being in error.

Argument 8 under (37 CFR 41.37(c)(1)(vii): Claim 2 is rejected under 35 U.S.C, 103(a) as being unpatentable over Laughlin ‘485 in view of Maples.

Maples (US 5,024,008) comprises “a rubber overshoe to be worn over a boot worn by the hunter” with an animal “scent dispenser...which is attached to the overshoe for dispensing scent on the ground as the hunter walks” where the animal “scent dispenser is isolated from the boot so that the overshoe and dispenser may be removed from the boot...”. The rubber overshoe, which is *removable*, and is *not inherent* to the boot itself, is not scented, and unlike the present invention which claims normal wear of said shoe sole exposes fresh surface area of said scented material/formulation compound releases a desired aroma, and further in Maples, the “...scent source means includes a sponge and animal lure impregnated therein”. The presently claimed invention further does not

include the use of an overshoe with a “sponge dispenser and animal lure impregnated therein” to dispense an animal luring scent.

Additionally, Laughlin fails to teach an exterior outer sole as presently claimed, and the cited references do not teach the combination made by the Examiner, who is using hindsight provided by the present specification.

This rejection should be reversed as being in error.

Argument 9 under (37 CFR 41.37(c)(1)(vii): Claims 3 and 16 are rejected under 35 U.S.C. 103(a) are being unpatentable over Laughlin '485 in view of Williford (US 5,261,169) as presented in paragraph 12 on page 7 of the final Office Action.

Claims 3 and 16 are rejected under 35 U.S.C. 103(a) are being unpatentable over Laughlin '485 in view of Williford. Williford (US 5,261,169) discloses where the "...article is a shoe insole and the active composition is an anti-microbial powder." Again, the examiner has mischaracterized the reference. In actuality, Williford more closely resembles Laughlin than the present disclosure in that the insole is installed in the interior surface of a shoe where the user's foot resides, and comes in direct contact with the foot of the shoe wearer.

An intended purpose for Laughlin and Williford, is to mask or counteract foot odors using a deodorizing/counteracting insole, whereby the present invention has no deodorizing/anti-microbial agent for insoles, but is rather intended to provide a scent to the exterior outer sole of the shoe, boot, etc. Additionally, there is no suggestion in Laughlin and Williford for scenting the exterior outer sole of a shoe or boot, as presently claimed.

However, the cited reference has nothing to do with the claimed invention as recited in the pending claims and in the specification. Appellant's invention claims and describes an exterior sole that has scented material added to the exterior sole material itself or to inserts that gives off a novelty scent (novelty has been removed due to rejections by the Examiner).

The claimed invention has nothing to do with insoles and the Examiner has simply redefined the claimed invention to include insoles in order to read the claims onto the prior art when the claims and the specification have nothing to do with insoles. This is specifically stated and taught by the present specification, e.g., under the Summary of the Invention, second paragraph on page 6: "In many scent related disclosures not having

anything to do with the present invention, scent is used to mask offensive odors, such as room deodorizers.”

Claim 1 recites a shoe sole for a shoe (which does not include an insole, the normal use of the term sole refers to the exterior sole only) as an exterior sole, as fully supported by the present specification, e.g., at pages 3-7.

Laughlin is an insole that is separate and distinct from the claimed sole of a shoe, where the insole is inserted into the inside of the shoe as distinct from the existing exterior sole of the shoe. As distinct from the presently claimed invention, an insole is separate and distinct from a shoe sole. An insole is an after market product that is inserted inside a shoe that already has a sole. An insole is put inside shoe, separate from the shoe itself.

Additionally the presently claimed invention provides a novelty scent due to the presence of a scented material that is on the exterior of the shoe sole, that gives off a novelty scent due to wear of the exterior sole from normal use or wear.

Unlike the present invention, Laughlin does not come in direct contact with indoor and outdoor ground surfaces such as pavements, floor coverings, etc. An intended purpose for Laughlin is “to mask or counteract foot odors”, whereby the present invention has no deodorizing aspects for insoles, but is rather meant to provide a scent to the exterior outer sole of the shoe, boot, etc.

Thus, the present invention does not recite, disclose, include or suggest insoles, but discloses and claims scented shoe soles. Accordingly, the cited reference fails to disclose, teach or suggest each and every element of the present claims.

Looking at this obviousness rejection under the Graham factors, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.

In particular the scope and content of the prior art teach that inner soles can be scented to address foot odor according to Laughlin '485 and foot microbial contamination that causes foot odor or fungus infection by adding an antimicrobial composition to the inner soles of a shoe according to Williford '169. The present invention provides an exterior outer shoe sole that incorporates a unique scent that is released upon wear of the shoe and thus provides a completely different function, as well as structure, from that of the cited art.

One of ordinary skill in the art would be taught either to scent inner soles to address foot odor or to add a microbial powder to the inner sole to address foot odor or infection, where one of ordinary skill would either be a foot inner sole engineer designing deodorants for inner soles *or* an antimicrobial engineer or designer for adding such to an inner sole, which would not present any of the functions of the present invention, and which would rely on a different person of ordinary skill in the areas of exterior outer sole engineering and fragrance engineering to add fragrance to the composition of an exterior outer sole of a shoe that was released as a unique aroma to the shoe wearer upon ordinary wear of the shoe by said wearer (not deodorant or microbial powder in the inner sole to address foot odor or infection).

Additionally, in Williford, the primary intended purpose of any use of anti-microbial powder is greatly different than the smoking compound comprising the present invention. Williford teaches that the primary intended purpose of the anti-microbial powder is to counteract foot odors, whereby the present invention "teaches away" from Williford in that the primary intended purpose of the smoking compound (sans any anti-microbial agent) is as an amusing and attractive feature to the shoe wearer that influences the purchasing and the wearing of the shoe, and, unlike Williford, has no relation whatsoever to the addressing or mitigating of foot odor issues. Williford further teaches away from the present invention that the anti-microbial powder entails contact with the actual foot of

the wearer, whereby the smoking compound of the present invention is triggered by wear and tear of the exterior sole due to direct contact with indoor and outdoor ground surfaces such as pavements, floors coverings, etc., whereby the smoking compound does not have direct contact with the actual foot of the wearer.

Accordingly the application of the Graham factors, as well as how the cited references “teach away” from the present invention with regards to the intended purpose relating to the use of scent, or powder and smoking compounds, results in the inescapable conclusion that the presently claimed invention is not obvious over the cited references, which one of ordinary skill would not and could not combine to make obvious the presently claimed invention.

Thus, the present invention does not recite, disclose, include or suggest insoles, but discloses and claims scented shoes having scented exterior soles further comprising a smoking compound. Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims.

Accordingly, the present claims distinguish over the cited reference(s). Accordingly, Appellant respectfully requests reconsideration and withdrawal of this rejection.

This rejection should be reversed as being in error.

Argument 10 under (37 CFR 41.37(c)(1)(vii): Claims 4 and 5 are rejected under 35 U.S.C. 103(a) are being unpatentable over Laughlin ‘485 in view of O’Brien (US 5,039,243) as presented in paragraph 13 on pages 7-8 of the final Office Action.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) are being unpatentable over Laughlin ‘485 in view of O’Brien. O’Brien (US 5,039,243) discloses fragrance releasing crayons. In the present invention, the colored sole is visible from the *outside* of the shoe as it is worn, whereas with Laughlin ‘485, the colored scenting means could only be visible from

the *inside* of the shoe. There is no suggestion or motivation to combine a reference for scented crayons with deodorizing insoles, such that the combination is improper under the MPEP.

However, the cited reference has nothing to do with the claimed invention as recited in the pending claims and in the specification. Appellant's invention claims and describes an exterior sole that has scented material added to the exterior sole material itself or to inserts that gives off a novelty scent (novelty has been removed due to rejections by the Examiner).

The claimed invention has nothing to do with insoles and the Examiner has simply redefined the claimed invention to include insoles in order to read the claims onto the prior art when the claims and the specification have nothing to do with insoles. This is specifically stated and taught by the present specification, e.g., under the Summary of the Invention, second paragraph on page 6: "In many scent related disclosures not having anything to do with the present invention, scent is used to mask offensive odors, such as room deodorizers."

Claim 1 recites a shoe sole for a shoe (which does not include an insole, the normal use of the term sole refers to the exterior sole only) as an exterior sole, as fully supported by the present specification, e.g., at pages 3-7.

Laughlin is an insole that is separate and distinct from the claimed sole of a shoe, where the insole is inserted into the inside of the shoe as distinct from the existing exterior sole of the shoe. As distinct from the presently claimed invention, an insole is separate and distinct from a shoe sole. An insole is an after market product that is inserted inside a shoe that already has a sole. An insole is put inside shoe, separate from the shoe itself.

Additionally the presently claimed invention provides a novelty scent due to the presence of a scented material that is on the exterior of the shoe sole, that gives off a novelty scent due to wear of the exterior sole from normal use or wear.

Unlike the present invention, Laughlin does not come in direct contact with indoor and outdoor ground surfaces such as pavements, floor coverings, etc. An intended purpose for Laughlin is “to mask or counteract foot odors”, whereby the present invention has no deodorizing aspects for insoles, but is rather meant to provide a scent to the exterior outer sole of the shoe, boot, etc.

Thus, the present invention does not recite, disclose, include or suggest insoles, but discloses and claims scented shoe soles. Accordingly, the cited reference fails to disclose, teach or suggest each and every element of the present claims.

Furthermore, the present invention “teaches away” from the cited reference with regards to the intended purpose of the use of scent. In Laughlin, the primary intended purpose of scent is to act as “[a] deodorizer for masking foot and shoe odors”, whereby the present invention teaches away from Laughlin in that the primary intended purpose of the scent is as an attractive feature to the shoe wearer that influences the purchasing and the wearing of the shoe, and therefore, unlike Laughlin, has no relation whatsoever to the addressing or mitigating of foot and shoe odor issues.

The only intended purpose for Laughlin ‘485 is to mask or counteract foot odors using a deodorizing insole, whereby the present invention has no deodorizing aspects for insoles, but is rather meant to provide a scent to the exterior outer sole of the shoe, boot, etc. Additionally, there is no suggestion in Laughlin for scenting the exterior sole of a shoe or boot, as presently claimed, and O’Brien’s suggestion for scented crayons in no way makes up for the deficiencies of Laughlin in failing to suggest the presently claimed shoe having scented exterior outer soles. As these references are in no way related, the Examiner only could have used hindsight provided by the present specification to make this combination of references.

Looking at this obviousness rejection under the Graham factors, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue

are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.

In particular the scope and content of the prior art teach that inner soles can be scented to address foot odor according to Laughlin '485 and scented crayons according to O'Brien '243. The present invention provides an exterior outer shoe sole that incorporates a unique scent that is released upon wear of the shoe and thus provides a completely different function as well as structure from that of the cited art.

One of ordinary skill in the art would be taught either to scent inner soles to address foot odor or to scent crayons for drawing with an added fragrance, where one of ordinary skill would either be a foot inner sole engineer designing deodorants for inner soles or a crayon designer for adding fragrance to a crayon, which would not present any of the functions of the present invention, and which would rely on a different person of ordinary skill in the areas of outer sole engineer and fragrance engineer to add fragrance to the composition of an outer sole of a shoe that was released as a unique aroma to the shoe wear upon ordinary wear of the shoe by the wearer (not deodorant or microbial powder in the inner sole to address foot odor or infection).

As discussed earlier, Laughlin '485 "teaches away" from the present invention with regards to the intended purpose of the use of scent. Furthermore, Laughlin and O'Brien '243 also "teach away" from each other with regards to the intended purpose of the use of scent! Laughlin teaches where the primary intended purpose of scent is to act as "[a] deodorizer for masking foot and shoe odors", whereby O'Brien teaches that scented crayons function as "a fragrance releasing device" whose scent is obviously *not* intended to mask odors, but rather where the intended purpose of the use of scent comprises an attractive feature to the crayon user that influences the purchasing and use of the scented crayons.

Accordingly the application of the Graham factors, as well as how the cited references “teach away” from each other with regards to the intended purpose relating to the use of scent, results in the inescapable conclusion that the presently claimed invention is not obvious over the cited references, which one of ordinary skill would not and could not combine to make obvious the presently claimed invention.

Thus, the present invention does not recite, disclose, include or suggest insoles, but discloses and claims shoes having scented exterior shoe shoes. Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. Reconsideration and withdrawal of this rejection is requested.

This rejection should be reversed as being in error.

Conclusion

In view of the above arguments and evidence of record, Appellants request that the Examiner’s objections and rejections be reversed and the case remanded to the Examiner for allowance.

The Examiner is invited to contact Appellant with any questions or comments.

Respectfully submitted,

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CLAIMS ON APPEAL

1. (Previously Amended) A shoe sole for a shoe comprising at least one scented material/formulation compound as a component of the shoe sole and/or as provided in a shoe sole plug or insert, where said scented material/formulation compound comprises at least one scent or fragrance

- (a) where said scented material/formulation compound gives off a desired aroma when said shoe sole is at rest;
- (b) where said scented material/formulation compound gives off a desired aroma when said shoe sole is in normal use due to friction, heat buildup, and wear; or
- (c) where said novelty scented material/formulation compound gives off a desired aroma when normal wear of said shoe sole exposes fresh surface area of said scented material/formulation compound,

and wherein said desired aroma comprises a salient, distinctive, and marketable feature of said shoe.

2. (Previously Amended) The shoe sole of claim 1, further comprising including where said scented material/formulation compound comprises at least one desired pheromone in addition to, or in place of, said at least one scent or fragrance.

3. (Previously Amended) The shoe sole of claim 1, further comprising including where said scented material/formulation compound comprises at least one smoking means in addition to, or in place of, said at least one scent or fragrance and/or at least one pheromone.

4. (Original) The shoe sole of claim 1, further comprising including where said shoe sole comprises materials that are colored in accordance to the scent of said shoe sole.

5. (Original) The shoe sole of claim 1, further comprising including where a given pair of shoes comprise a mixed set, where each shoe sole in said given pair comprises a different scent.

6. (Previously amended) The shoe sole of claim 1, further comprising including where said shoe sole comprises at least one void anywhere on the outside surface of said shoe sole, where said void comprises a receptacle that is intended for and allows for the insertion of at least one scented plug or insert, where said void comprises a hole of any shape, design, directional orientation, size, or depth, and/or a groove, channel, or crevice comprising any shape, design, design pattern, directional orientation, size, or depth,
7. (Previously amended) The shoe sole of claim 6, further comprising including where said shoe sole comprising said at least one void anywhere on the outside surface of said shoe sole, where said void comprises a receptacle that is intended for and allows for the insertion of at least one scented plug or insert, does not comprise said at least one scented material/formulation compound, and/or does not comprise at least one pheromone, and/or does not comprise at least one smoking means.
8. (Canceled)
9. (Previously Amended) The void of claim 6, further comprising including where said void can accommodate said at least one scented plug or insert comprising any embodiment of an "O" ring around the non-wearing circumference of the entire shoe sole, and/or around the non-wearing circumference of the heel portion of said shoe sole, and/or around the non-wearing circumference of the non-heel portion of said shoe sole; or where said "O" ring is in or on the wear surface of said shoe sole.
10. (Previously Amended) The void of claim 6, further comprising including where said void can accommodate two or more plugs or inserts, either along the depth of said void, side-by-side along/across the opening gap of said void, or both.
11. (Previously Amended) The scented plug or insert of claim 6, comprising where said plug or insert comprises any shape, design, size or depth, comprising where said plug or insert comprises any material composition, comprising where said plug or insert comprises any color or any colors, and comprising where said plug or insert is designed for or is able to be modified to be inserted, installed and/or secured in said void by any possible inserting, installing or securing means; further comprising

including where said plug or insert is removable from said void using any removing means.

12. (Previously Amended) The scented plug or insert of claim 11, comprising where said plug or insert may be formed by any forming means, where said any forming means comprises any means of molding, casting, die cutting, extruding and cutting, molding and cutting, casting and cutting, etc.
13. (Previously Amended) The scented plug or insert of claim 11, comprising where said plug or insert comprises semi-solids that are introduced into said void using any void-filling means, where said any void-filling means comprises any means of pouring, pumping, injecting, or spraying, etc.
14. (Previously Amended) The material composition of claim 11, further comprising including where said material composition comprises at least one scent or fragrance and/or pheromone.
15. (Previously Amended) The material composition of claim 11, further comprising including where said material composition comprises at least one visual aspect, where said visual aspect comprises any or interesting appearance items including items that are reflective, refractive, sparkling, shining, holographic, jewel-like, pearlescent, fluorescent, glow-in-the dark, etc., where said visual aspect does not produce light and does not comprise the use of a chemical reaction that produces light.
16. (Original) The material composition of claim 11, further comprising including where said material composition comprises at least one smoking means.
17. (Previously Amended) The scented plug or insert of claim 11, comprising where a singular said scented plug or insert comprises, in addition to at least one material composition, any one, or any combination or permutation comprising more than one, of the following attributes: at least one color; at least one scent and/or fragrance; at least one pheromone; at least one visual aspect; or at least one smoking means.
18. (Previously Amended) The scented plug or insert of claim 11, further comprising including where said scented plug or insert comprises a plug or insert comprising multi-sectional construction, where said plug or insert comprising said multi-sectional

construction comprises two or more sections, where any one given section, or more than one given sections comprising said two or more sections can be oriented either along the depth of said scented plug or insert comprising multi-sectional construction, and/or along or across the surface area that is visible after installation of said scented plug or insert comprising multi-sectional construction; further comprising including where said any one given section can comprise any one, or any combination or permutation comprising more than one, of the following attributes: at least one material composition; at least one color; at least one -scent and/or fragrance; at least one pheromone; at least one visual aspect; or at least one smoking means.

19. (Previously Amended) The scented plug or insert of claim 11, comprising where said scented plug or insert may be either factory installed on said shoe during the manufacturing process; or, where said scented plug or insert may be installed on said shoe by non-factory aftermarket installers.
20. (Previously Amended) The plug or insert of claim 11, further comprising including where the installation of said scented plug or insert on said shoe by factory installers or by aftermarket installers allows for said installation to comprise any number and/or combination of different scented plugs or inserts, where differences comprising a given scented plug or insert comprising said any number and/or combination of different scented plugs or inserts can comprise any variation with regards to any one or more of the following: at least one material composition; at least one color; at least one scent and/or fragrance; at least one pheromone; at least one visual aspect; at least one smoking means; single sectional versus multi-sectional construction; etc., where the use of said different scented plugs or inserts allows for the customization of said shoe to comprise endless variants and permutations.
21. (Previously Amended) The plug or insert of claim 11, further comprising including where said scented plug or insert, and/or semi-solid scented plug or insert material, is made available and/or sold as a separately offered aftermarket item or plurality of aftermarket items, to allow customization of said shoe sole comprising said at least one void by aftermarket installers; further comprising including where said separately offered aftermarket item or said plurality of aftermarket items can be used to

customize shoes other than said shoe through the modification of said shoes other than said shoe, where said modification comprises the creation of said at least one void by any void creating means that enables installation of said separately offered aftermarket item or said plurality of aftermarket items on said shoes other than said shoe.

Evidence Appendix Under 41.37(c)(1)(ix)

NONE.

There is no related evidence under 37 C.F.R. 1.130, 1.131, or 1.132 being filed with this Brief on Appeal.

Related Proceedings Appendix Under 41.37(c)(1)(x)

NONE.

There are no related proceedings pursuant to 41.37(c)(1)(ii).